

### Remarks

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 34 remain in this application.

#### **1. Allowable Subject Matter**

Applicants note with much appreciation the Examiner's allowance of claim 32 and claim 33, and further that the Examiner has indicated the subject matter of claims 8 – 17, 19, 20, and 22 - 24 are patentable and would be allowable if rewritten in independent form.

#### **2. The Final Status of Application**

The Applicants express their gratitude and appreciation for the Examiner's reconsideration of the finality of the previous office action.

#### **3. § 103 Rejections**

The Examiner has rejected claims 1 – 7, 18, 21, 25 – 31, and 34 under 35 U.S.C. § 103(a) as being unpatentable for obviousness over U.S. Patent No. 6,671,145 to Germain et al. (hereinafter Germain) in view of U.S. Patent No. 4,013,929 to Dietz et al. (hereinafter Dietz).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

##### A. The Cited References Do Not Teach or Suggest All the Claim Limitations

##### 1. Claims 1 – 31:

The Examiner does not establish a *prima facie* case of obvious because he does not show where the cited references teach or suggest all the claim limitations of claims 1 - 31.

The Examiner does not show where either Germain or Dietz, whether taken alone or in combination, teach or suggest the test circuit recited in claim 1. The Examiner does not assert that Dietz teaches the test circuit element, but rather, he alleges that Germain does. In particular, the Examiner points to Germain, col. 5, lines 4 – 24 in support of the rejection. Applicants respectfully point out to Examiner Kitov that the cited portion of Germain does not teach or suggest the claim element in question. In fact, it is quite the opposite. The relevant portion of the recited test circuit reads as follows:

“...the test circuit being configured to drive the lock-out mechanism from an unlocked state to the lock-out state if the fault detection circuit and/or power interruption circuit fails to respond to the simulated fault signal within a predetermined period of time.”

On the other hand, Germain teaches a test circuit that drives the lock-out mechanism from the lockout position to the unlocked position if the test passes. It does nothing, if the test fails.

The cited portion of Germain reads:

“If the circuit interrupting device is operational and properly wired as shown by the test, the solenoid forces plunger 54 to slide latch 60' in direction B ... allowing the reset plunger 78' to complete its journey in direction A ... to complete the reset of the device. As can be appreciated, if the test fails, the latch 60' will not move in direction B ...and the device will be locked out from the reset function.”

In comparing the claim language to the cited portion of Germain it becomes clear that the teaching of Germain is completely opposite to the claimed invention. Germain teaches a test apparatus that *drives the lockout from a locked position to an unlocked position if the test passes*. On the other hand, the claimed invention recites a test circuit that *drives the lockout mechanism from an unlocked state to a locked state if the test does not pass within a predetermined period of time*. Viewing the present invention from another direction, the test circuit of the present invention remains in the unlocked state if the test passes within a predetermined period of time. Clearly, Germain teaches a test apparatus that remains locked if the test fails – a lockout mechanism predicated by timing is simply not disclosed, taught or suggested by Germain.

The Examiner relies on Dietz for teaching and/or suggesting a bus bar mechanism for actuating a set of movable contacts. Accordingly, the Examiner makes no representation that Dietz remedies any of the deficiencies pointed out in the above paragraph with regard to Germain. Thus, neither Germain nor Dietz, whether taken alone or taken in combination, teach or suggest the test circuit recited in claim 1 of the present invention. Accordingly, neither Germain nor Dietz, whether taken alone or taken in combination, teach or suggest all the claim limitations recited in claim 1. While the dependent claims are allowable in their

own right, indeed the Examiner has indicated that many are allowable, they are also allowable by virtue of their dependency from claim 1.

Claim 18, for example, includes a “second circuit element being configured *to drive the test circuit from the unlocked state to the lock-out state if the fault detection circuit and/or the power interruption circuit fail to respond to the at least one fault condition within the predetermined time period.*” Again, Germain teaches a test apparatus that drives the lockout from a locked position to an unlocked position if the test passes. The teaching of Germain is exactly opposite to the claimed invention.

Independent claim 34:

Claim 34 is similar to claim 18 in that it recites a “second circuit element being configured *to drive the test circuit from the unlocked state to the lock-out state if the fault detection circuit and/or the power interruption circuit fail to respond to the at least one fault condition within the predetermined time period.*” As noted above, the teaching of Germain is exactly opposite to the claimed invention.

**Response to the Examiner’s Arguments**

The Examiner correctly restated the portion of claim 1 at issue: “...*the test circuit being configured to drive the lock-out mechanism from an unlocked state to the lockout state if the fault detection circuit and/or the power interruption circuit fails...*” In other words, claim is directed to a protective device that moves from an unlocked state to a locked state if the device fails to respond.

The Examiner also correctly restates the relevant portion of Germain in col. 5, lines 20 – 25, i.e., that “*if the test fails, the latch 60’ will not move...*” There is a clear dichotomy between Germain and claim 1. The device recited in claim 1 has a default position in the *unlocked state* and generates an active response in the event of a failure and moves from an unlocked state to a locked state. Germain, on the other hand, has a default position in the *locked state* and is, therefore, passive in the event of a failure.

After correctly stating the premise of the applicants’ argument, the Examiner inexplicably concludes that “Germain does teach this limitation of the claim.” The applicants can only respond by noting that the Examiner’s conclusion is a non-sequitur because his conclusion simply does not follow from the premise.

The Examiner also states that “Applicant is wrong alleging that Germain’s invention ‘does nothing, if the test fails.’” The applicants respectfully note that the Examiner does not back up this statement with any evidence from the Germain disclosure. Further, the Examiner’s own correct restatement of the relevant portion of Germain contradicts the above statement. Again, col. 5, lines 20 – 25 indisputably state that “*if the test fails, the latch 60’ will not move...*” In other words, latch 60’, which controls the movement between the locked state and the unlocked state, does nothing such that Germain remains in the locked state.

Accordingly, the applicants respectfully assert that claims 1 – 7, 18, 21, 25 – 31, and 34 are patentable under 35 U.S.C. § 103(a). The applicants also respectfully assert that the Examiner has not made a prima facie case of obviousness because he does not show where the references teach or suggest all the claim limitations.

**B. There is No Suggestion or Motivation to Combine Reference Teachings**

It is well established that *if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, the object of Dietz is to provide a miniature device that eliminates a switch, as well as other components, by utilizing the main breaker of the protected circuit to perform the additional function of opening and closing the GFI circuit that energizes the trip coil. See Dietz, col. 2, lines 45 – 52. This modification would render Germain inoperable and, thus, make Germain unsuitable for its intended purpose.

**Response to the Examiner’s Arguments**

In paragraph 3 of the *Response to Arguments* Section of the Examiner’s response, the Examiner does not address the points raised in the applicants’ last response. Instead, the Examiner argues that “*the Examiner never suggested bodily incorporation...*” and supplies PTO boilerplate that reminds the applicants that “*the test for obviousness is not whether the features of one reference may be bodily incorporated into the other...In re Bozek*, 163 USPQ 545 (CCPA 1969).” The case cite is all well and good but it is not directed to the applicants’ argument. Rather, the applicants are asking the Examiner to respond to their arguments based on *In re Gordon*.

The applicants respectfully assert that claims 1 – 7, 18, 21, 25 – 31, and 34 are patentable under 35 U.S.C. § 103(a) because the references are not properly combinable.

C. Summary

The applicants respectfully assert that a prima facie case of obviousness has not been made during the prosecution of the present invention because the instant rejection, as well as the previous rejections, do not show where the cited references teach or suggest all the claim limitations and do not provide a proper motivation to combine the cited references. The applicants respectfully assert that claims 1 – 7, 18, 21, 25 – 31, and 34 are patentable under 35 U.S.C. § 103(a) and respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

#### 4. Conclusion

Based upon the remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 34 and a prompt Notice of Allowance thereon.

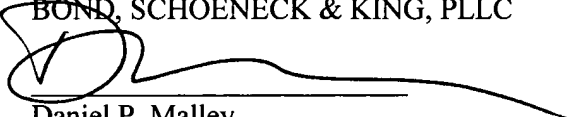
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-1546.

Please direct any questions or comments to Daniel P. Malley at (607) 330-4010.

Respectfully submitted,

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